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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/854,311

05/10/2001

Joseph Neev

NEEVJ-11087.PAT

7823

56549

7590

04/01/2008

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EXAMINER

SHAY, DAVID M

ART UNIT

PAPER NUMBER

3735

MAIL DATE

DELIVERY MODE

04/01/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/854,311	<b>Applicant(s)</b> NEEV, JOSEPH	
	<b>Examiner</b> david shay	<b>Art Unit</b> 3735	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on January 11, 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 21-23,25,29,33-35,38-40,45-51 and 54-63 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-23,25,29,33-35,38-40,45-51 and 54-63 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 11, 2008 has been entered.

The substitute specification filed January 11, 2008 has been entered.

The drawings are objected to because the figure numbering is non-consecutive and appears random; the vast majority of the figures have none of the elements labeled with indicia indicative of their function; one figure is not numbered. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “generally solid absorbing material”, which is part of the device and the “device sized and configured to be held in the hand” must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The amendments filed January 11, 2008 and April 24, 2007 are objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: “a system for enhancing

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or improving the transcutaneous or transdermal delivery of various topical substances, chemicals, or drugs”.

Applicant is required to cancel the new matter in the reply to this Office Action.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 21-23, 25, 29, 33-35, 38-40, 45-51, and 54-63 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In the claims the exact meaning of the term “generally solid” is unclear and the term lacks positive antecedent basis in the specification as originally filed.

Claims 38-40, 49-51, 54-56, and 58-63 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The originally filed disclosure is silent on “device sized and configured to be held in the hand” and “thereby to enhance transdermal drug delivery”.

Claims 21-23, 29, 33-35, 45, 47, and 48 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Neev (WO '438).

See Figures 11A, 11B, 13A-E, and the disclosure associated therewith wherein the absorbing material is considered “generally solid” since it forms a film which remains on the skin throughout wax depillation.

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Claims 25 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neev (WO '438). Neev (WO '438) teaches a device as claimed except the particular intermediate substance. It would have been obvious to the artisan of ordinary skill to employ the various intermediate materials such as agar and tracing paper, since these are equivalents to the liquids and solids of Neev (WO '438) as they can all conform to the tissue surface and retain an absorbing substance; are not critical; and provide no unexpected result, and to manipulate the proportion of absorbent material in the mixture so as to cause a certain percentage of the laser light to be converted into heat since this is not critical; is well within the scope of one having ordinary skill in the art; and provides no unexpected result, thus producing a device such as claimed.

Claims 38-40, 49-51, and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neev (WO '438) in combination with Baker et al. Neev (WO '438) teaches a method as claimed except the removal of blemishes. Baker et al teach the desirability of removing blemishes by ablating very thin layers of tissue. It would have been obvious to the artisan of ordinary skill to employ the thin layer of tissue removal steps of Neev (WO '438) in the method of Baker et al, since this allows the ablation of extremely thin layers of tissue and thus affords greater precision in tissue removal, or to employ the blemish removal method of Baker et al in the method of Neev (WO '438), since this would provide the dual functionality of removing the blemish, while still enabling the removal of analytes, or, alternatively, the infusion of drugs which would help treat the blemish, and to employ other forms of energy such as microwaves and ultrasound, since this is not critical; is well within the skill of one having ordinary skill in the

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art; and provides no unexpected result and can be absorbed to create heat, thus producing a device such as claimed.

Claims 55-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neev (WO '438) in combination with Eckhouse et al. Neev (WO '438) teaches a device as claimed except the cap and the device being cylindrical. Eckhouse et al teach the desirability of applying substances to the applicator portion of the device. It would have been obvious to the artisan of ordinary skill to include the substance as part of the device, since this is not critical; is well within the skill of one having ordinary skill in the art; and provides no unexpected result, and can provide cooling, as taught by Eckhouse et al, to configure the device to be cylindrical, since this is not critical; is well within the skill of one having ordinary skill in the art; would make the device more easily graspable and manipulable by the hand; and provides no unexpected result; to include the substance in the form of a cap, since these are typically used in contact medical devices sterility purposes, official notice of which is hereby taken, and to use an energy source which outputs less than 5 watts, since this is not critical; is well within the skill of one having ordinary skill in the art; and provides no unexpected result, thus producing a device such as claimed.

Applicant's arguments with respect to claim s 21-23, 25, 29, 33-35, 38-40, 45-51, and 54-63 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to david shay whose telephone number is (571) 272-4773. The examiner can normally be reached on Tuesday through Friday from 6:30 a.m. to 5:00 p.m.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor, II, can be reached on Monday, Tuesday, Wednesday, Thursday, and Friday. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/david shay/

Primary Examiner, Art Unit 3735